

### **Remarks**

The Applicants thank the Examiner for examining the claims of the present application and finding that claims 1-7 and 14 recite allowable subject matter. As more fully set forth below, the Applicants respectfully request reconsideration of the Examiner's rejection of claims 8-11, 13, and 16-19.

#### **Independent Claim 8 Is Patentable Over *O'Connell* in view of *Yadav***

The Examiner rejects independent claim 8 as being obvious under 35 U.S.C. § 103(a) over U.S. Patent 6,267,776 ("*O'Connell*") in view of U.S. Patent 6,391,044 ("*Yadav*"). (Office action, pg. 2.) The Examiner's rejection is respectfully traversed.

Independent claim 8 recites:

a venous filter comprising a web comprising a dissolvable material; and at least two anchors, wherein said at least two anchors are configured to retain said web within a mammalian blood vessel, wherein said dissolvable material comprises one piece of material that is spiraled from the outside in.

The Examiner admits, and the Applicants agree, that "*O'Connell* fails to teach [that] the dissolvable material comprises one piece of material that is spiraled." (Office action, pg. 3.)

The Examiner contends, however, that FIG. 10 of *Yadav* teaches this element and that it would have been obvious "to modify the filter of *O'Connell* to include the spiral in view of *Yadav et al.* as an alternative to struts of *O'Connell*." The Applicants disagree.

First, the spiral in FIG. 10 of *Yadav* is "a single spiral structural wire 130 which is attached to the filter 107" and which "unwinds and deploys filter 107" as tension fiber 131 is released. (*Yadav*, col. 7, lines 63-66.) As can be seen in FIG. 10, the structural wire 130 is a solid, thin wire used only to support the filter 107 and aid in its deployment. The structural wire 130 of *Yadav* is not part of the filter membrane or of any "web" of the filter. Accordingly, *Yadav* also fails to teach "a web comprising a dissolvable material . . . wherein said dissolvable material comprises one piece of material that is spiraled from the outside in" as in independent claim 8.

Additionally, *Yadav* expressly teaches away from a "venous filter comprising . . . at least two anchors" as in independent claim 8. More specifically, in the section entitled "object of the invention," *Yadav* states: "It is a further object of the invention to provide a vascular filter system having a configuration which does not require hooks to penetrate and grip the blood

vessel walls, so that the implantation results in less blood vessel injury.” (*Yadav*, col. 2, lines 37-40.) Instead, in *Yadav*, “the filter membrane deploys in an umbrella-like fashion with the unattached edge of the member moving upward, i.e., distally, and outward until it is in firm contact with an artery wall.” (*Yadav*, col. 4, lines 37-40.) Accordingly, because one of the express objects of *Yadav* is to provide a filter system that does not use hooks (a type of anchor) so that implantation of the filter results in less blood vessel injury, one of ordinary skill in the art would not have modified *O’Connell* in view of *Yadav* to create a “venous filter comprising . . . at least two anchors.” See MPEP § 2145.X.D.1 (“A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness . . . .”)

Furthermore, the filter embodiment of *O’Connell* relied on by the Examiner expressly teaches to use hooks — in direct contradiction to the teachings of *Yadav*. In relevant part, *O’Connell* states: “FIG. 31 shows a cross-sectional view of the filter legs of filters 500, 600 and 700 expanding radially outwardly into an open and stent-like configuration when the releasable retainer is removed. A small hook 32 on each blunted superior end of each filter leg engages the wall of the vessel to securely fix the expanded filter within the blood vessel.” (*O’Connell*, col. 13, lines 31-36.) Thus, the teachings of *O’Connell* directly contradict the teachings of *Yadav*. Because the references themselves teach away from their combination, one of ordinary skill in the art would not have modified *O’Connell* in view of *Yadav*. See MPEP § 2145.X.D.2 (“It is improper to combine references where the references teach away from their combination.”)

Finally, the Examiner’s proposal to “include the spiral in view of *Yadav* et al. as an alternative to [the] struts of *O’Connell*” would eliminate the filter legs of *O’Connell*, including the portions 702 and 708 relied on by the Examiner to show the “at least two anchors.” Thus, it appears that the Examiner’s proposed modification of *O’Connell* would itself result in a filter that does not have “at least two anchors.”

For at least these reasons, independent claim 8 is not obvious under 35 U.S.C. § 103 over *O’Connell* in view *Yadav*. Accordingly, the Examiner’s 35 U.S.C. § 103(a) rejection should be withdrawn and such action is respectfully requested.

**Dependent Claims 9-11, 13, and 15-19 Are Also Patentable**

Claims 9-11, 13, and 15-19 depend from independent claim 8 and are patentable for at least the reasons recited above with respect to claim 8. Claims 9-11, 13, and 15-19 are also patentable for the novel and nonobvious combinations of features recited in each respective claim.

**Conclusion**

In view of the above remarks, all of the pending claims of the application are believed to be in condition for allowance. Should any further issues remain, the Examiner is invited to call the undersigned attorney at (503) 595-5300.

Respectfully submitted,

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